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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/534,885

12/19/2005

Werner Seeger

12007-0051

8754

22902

7590

07/28/2010

CLARK & BRODY

1700 Diagonal Road, Suite 510

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EXAMINER

RIDER, LANCE W

ART UNIT

PAPER NUMBER

1618

MAIL DATE

DELIVERY MODE

07/28/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/534,885	Applicant(s) SEEGER ET AL.	
	Examiner LANCE RIDER	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-17 and 25-35 is/are pending in the application.
- 4a) Of the above claim(s) 13-17 and 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

The remarks and amendments filed on June 9th 2010 are acknowledged. Claims 1-12 and 18-24 are canceled, claims 13-17 are withdrawn, and claims 25-35 are newly added.

Election/Restrictions

Newly submitted claim 35 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 35 is drawn to a method of making particles whereas the previously examined claims are drawn to the particles themselves.

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the particles could be made by a materially different method such as by using other non-aqueous solvents during emulsification or spray drying the particles through small nozzles without emulsification.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 35 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to arguments

Withdrawn Rejections

Receipt and consideration of Applicants' amended claim set and remarks filed on June 9th 2010 is acknowledged. Rejections and objections not reiterated from previous office actions are hereby withdrawn. The following rejections or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Maintained Rejections

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The rejection of claims 25 and 28-34 under 35 U.S.C. 103(a) as being unpatentable over Kissel et al. "Protein Delivery Systems Based on Branched Biodegradable Polyesters" ("Kissel") in view of US 6,908,626 ("the '626 patent") is maintained.

Applicant argues that "obviousness. This is because the invention is concerned with colloidal particles and the problems associated with these particles in aqueous solutions. The invention and D1 are concerned with completely different systems and problems. Consequently, one of skill in the art knowing the teaching of D1 concerning stabilizing nanoparticles in a mix of nanoparticles and micronized particles, would not conclude that CMC could be used in the context of the present invention, which relates to the formation of colloidal particles. Put another way, the Examiner does not have the proper reasoning to apply the teachings of D1 to D3 and allege that claim 25 is obvious."

It is not entirely clear what applicant is arguing above, but aqueous nanoparticles and microparticles which require surface stabilization are types of colloidal particles. In the event that applicant was alleging that the prior art used was not analogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the prior art is drawn to polymeric drug delivery particles and drugs which can be delivered by such particles. Applicant also seems to allege that the prior art and the instantly claimed invention are drawn to different areas, the instant invention being drawn to non-aqueous particles? In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., non-aqueous/nebulized particles) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant also states that the present invention provides for unexpected results, i.e. their unexpected stability upon nebulization.

In response to this argument, the claims themselves are not drawn to nebulized particles and thus the claim to unexpected results is not comesurate in scope with the instant claims. Further the rational for adding CMC to the particles was in order to stabilize the polymer particles disclosed in the Kissel reference. This surface

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stabilization would stabilize the particles in both aqueous and nebulized forms as the agglomeration is related to the surface charge of the particles, thus stabilizing the surface and altering its charge with CMC would work in both environments. It is therefore difficult to see how the claimed combination provides an unexpected benefit as this benefit of increased stability is exactly the benefit cited for combining the references.

The rejection of claims 26-27 under 35 U.S.C. 103(a) as being unpatentable over Kissel in view of the '626 patent, as applied above, and in further view of US 5,049,582 ("the '582 patent") is maintained.

Applicants argue that the Adler reference does not remedy the deficiencies of the Kissel '582' and Cooper '626' references.

As stated above, the Kissel and Cooper references have no deficiency. Adler was added to show the use of the drug iloprost which is beneficial for preventing kidney disease before the time of the invention and does not need to remedy any deficiency of the Kissel or Cooper references.

New Grounds of Rejections

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 25-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The polymer of claim 25 where p_{OH} and n_{OH} have been included in the polymer are not found anywhere in the originally filed specification or claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have claimed a polymer with additional monomers c and d which are required to be 0%. Do the claims have instantly claimed monomers present or not? If there are no such monomers in the polymer, then why are they included in the structure? The claim also recites where $p_{OH} n_{OH} - (a+b+c+d)\%$. Does this mean that p_{OH} is equal to n_{OH} minus the added percentages of $(a+b+c+d)$ or p_{OH} is a percentage itself that is equal to $[n_{OH} - (a+b+c+d)]/100$? Claims 26-34 depend on this independent claim and do not rectify the indefinite nature of the claim.

Conclusion

No claims allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LANCE RIDER whose telephone number is (571)270-1337. The examiner can normally be reached on M-F 11-12 and 1-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571)272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LANCE RIDER/
Examiner, Art Unit 1618

/Michael G. Hartley/
Supervisory Patent Examiner, Art
Unit 1618